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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Osamu TAKAHASHI

Group Art Unit: 2625

Application No.: 10/813,271

Examiner: D. EBRAHIMI

Filed: March 31, 2004

Docket No.: 119305

For: PRINT CONTROLLER, PRINTER, AND PROGRAM

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the October 6, 2008 Restriction Requirement, Applicant provisionally elects Group I, claims 1-23, 25, 26, and 28, with traverse.

The Office Action asserts that Inventions I and II are related as a combination and subcombination and that the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination has separate utility (see Office Action at p. 2). The criteria for a proper restriction between potentially distinct inventions are that the inventions must be independent and there would be a serious burden on the Examiner if the restriction is not required (See MPEP § 803). In addition, to support a Requirement for Restriction, both two-way distinctness and reasons for insisting on the restriction are necessary (See MPEP § 806.5(c)).

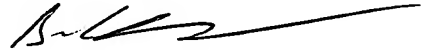
The restriction requirement is not proper because the Examiner has not shown two-way distinctness. To establish two-way distinctness, the Examiner must show that the combination as claimed does not require the particulars of the subcombination as claimed for

patentability and that the subcombination can be shown to have utility either by itself or in another materially different combination (See MPEP §806.05(c)). To support the restriction requirement, the Office Action states that the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination has separate utility (See Office Action at p. 2). However, this statement is merely conclusive and does not provide support for the for the Restriction Requirement.

Further, it is respectfully submitted that the subject matter of all claims is sufficiently related that a thorough search for the subject matter of any one Group of claims would encompass a search for the subject matter of the remaining claims and that the search and examination of the entire application could be made without serious burden. The Examiner already has examined the subject matter of all the claims because it issued a February 27, 2008 Office Action addressing all claims. Further, the Amendment filed May 27, 2008 in response to the February 27, 2008 Office Action merely addressed formalities and did not change the scope of the claims. The Examiner also has stated no reasons as to why such an examination would impose a serious burden. See MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicant and duplicative examination by the Patent Office.

Thus, withdrawal of the Restriction Requirement is respectfully requested.

Respectfully submitted,



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